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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,258	12/09/2003	Gaku Ehara	031294	3331

23850 7590 07/21/2006

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EXAMINER

TONGUE, LAKIA J

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,258

Applicant(s)

EHARA ET AL.

Examiner

Lakia J. Tongue

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☒ Claim(s) 2-4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's response filed on April 17, 2006 is acknowledged. Claims 1-5 are pending and under consideration. Claim 6 has been canceled.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office Action.

Rejections Withdrawn

1. In view of applicants' response the rejection of claim 6 under 35 U.S.C. 103(a) as being obvious over Haynes et al in view of Fujiie et al on page 4, paragraph 5 is withdrawn.

2. In view of applicants' response the rejection of claims 2-6 under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps on page 3, paragraph 3 is withdrawn.

Objection/Rejections Maintained

3. The objection of claims 2-4 as being dependent upon a rejected base claim is maintained for the reasons set forth on page 2, paragraph 2.

4. The rejection of claims 1⁶ under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the

steps is maintained for the reasons set forth in the previous office action on page 3, paragraph 3.

Applicant urges that a) the omission of a recovery step does not amount to a "gap between the steps", since only one step is recited in claim 1, b) there is no apparent reason why "recovering the sporangia" is in any way essential to practicing the claimed invention and c) nothing in the preamble of claim 1 of claim 5 requires that the sporangia be isolated from the medium.

It is the examiner's position that claims 1-6 are drawn to a process for producing sporangia of *Bacillus popilliae* containing spores and parasporal bodies comprising the step of culturing *Bacillus popilliae* in a medium containing an adsorbent and 0.2-4.0% by weight of free glutamic acid. Applicant has provided a process for producing sporangia, however applicant has omitted the step of recovering the sporangia from the culture medium as demonstrated in applicants' disclosure on page 14, lines 7-8. Applicants' final product is sporangia containing spores and parasporal bodies recovered from the culture. This is the limitation that applicant has omitted, thus the rejection is maintained.

5. The rejection of claims 1 and 5 under 35 U.S.C. 102(b) as being anticipated by Haynes et al is maintained for the reason set forth in the previous office action on page 3, paragraph 4.

The rejection was on the grounds that Haynes et al disclose a process for producing sporangia of *Bacillus popilliae*. Haynes et al disclose that spores of *Bacillus popilliae* will form in liquid medium containing glutamic acid by weight of 18-21g/16g nitrogen (page 377, table1 and 381). The sporangia of *Bacillus popilliae* would inherently have the capability of serving as a control agent for Scarabaeidae insects. Limitations such as weight ratios are being viewed as limitations of optimizing experimental parameters.

Applicant urges that a) Haynes neither teaches nor suggest that free glutamic acid has an enhancing effect on sporangia formation, b) the reference does not discuss free glutamic acid nor the addition of free glutamic acid into the medium, c) Tables 2 and 5 have no information as to the amount of free glutamic acid and the ratio of free/conjugated glutamic acids and d) the sporangia of claim 5 would not be expected to be identical to those of Haynes.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., free glutamic acid having an enhancing effect on sporangia formation and the ratio of free/conjugated glutamic acids) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is the examiner position that although applicant directs the examiner to the definition of free glutamic acid to include physiologically acceptable salts thereof (last line of page 9 to page 10, line 4) applicant also discloses that the collection of 16 types of free amino acids are composed of a variety of amino acids one of which is glutamic acid (page 11, paragraph 2). Haynes et al discloses a medium that comprises glutamic acid, which by applicants' disclosure is equivalent to free glutamic acid. Moreover, applicant has not demonstrated via a side-by-side comparison that the medium of the prior art would not be capable of producing sporangia. Further, the amount and weight ratios of free glutamic acid would be a matter of optimizing experimental parameters.

By all comparative data the process and the medium of Haynes et al is identical to the instantly claimed invention therefore the sporangia of *Bacillus popilliae* would inherently have the capability of serving as a control agent for Scarabaeidae insects.

Conclusion

6. No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakia J. Tongue whose telephone number is 571-272-2921. The examiner can normally be reached on Monday-Friday 7-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


LST
7/7/06


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